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 Pages: 15 (Including this page)

Date: July 14, 2005  
 Attorney Docket No.: 4925-75

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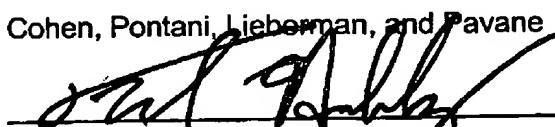
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**RESUBMISSION OF**  
**APPEAL BRIEF**  
**IN**  
**U.S. PAT. APP. SER. No. 09/764,709**

Contents: 14 pages of Appeal Brief

Because the fees for filing an Appeal Brief  
 have already been paid (on April 25, 2005),  
 it is believed that no fees are required at this time.  
 However, if any fees are required at this time,  
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Cohen, Pontani, Lieberman, and Pavane

  
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PATENT

Attorney Docket # 4925-75

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

**Jukka V. JOKINEN et al.**Serial No.: **09/764,709**Filed: **January 18, 2001**For: **Real-Time Wireless E-Coupon (Promotion)  
Definition Based On Available Segment**Examiner: JANVIER, Jean D.  
Group Art: 3622

I hereby certify that this correspondence is being  
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*Teodor A. Stenberg*  
Name of applicant, witness or Person Authorized to receive  
Signature

July 14, 2005  
Date of Signature

Via Facsimile: (703) 872-9306**[RESUBMITTED] APPEAL BRIEF**

SIR:

On April 25, 2005, applicants filed an Appeal Brief in accordance with 37 C.F.R. §41.37. On July 12, 2005, the Examiner issued a Notification of Non-Compliant Appeal Brief, asserting that because the issue discussed in an addendum on page 14 of the Appeal Brief was not an appealable matter, the addendum "renders the Brief defective, Applicant is required to delete the said addendum before re-submitting the Brief". In response, applicants are re-submitting the Appeal Brief herewith, with the offending addendum deleted.

Because the fee of \$500 for filing an Appeal Brief has already been paid (with the original submission of this Appeal Brief), it is believed that no fees are required at this time; however, if any fees are required at this time, please charge them to our Patent & Trademark Office Deposit Account 03-2412.

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The sections below are numbered in accordance with §41.37(c).

**(i) Real Party in Interest:**

The real party of interest herein is Nokia Corporation, Keilalahdentie 4, Espoo, Finland, FIN-02150.

**(ii) Related Appeals and Interferences:**

There are no related appeals and/or interferences of which appellant is aware.

**(iii) Status of Claims:**

Claims 1-34 are pending, with Claims 1, 5, 17, 21, and 25 being in independent form. In the November 12, 2004 Final Office Action, the Examiner rejected independent Claims 1, 17, and 21 as unpatentable under 35 U.S.C. §103 over U.S. Patent No. 5,539,395 (Buss) in view of U.S. Patent No. 6,332,127 (Bandera), and independent Claims 5 and 25 were rejected under 35 U.S.C. §102 as anticipated by Buss.

**(iv) Status of Amendments:**

There was an amendment filed on January 12, 2005, subsequent to the final rejection, in which Claim 1 was amended to add a missing "and", and Claims 21-22 were amended to correct for improper antecedent basis. The amendment seems to have been entered by the Examiner.

**(v) Summary of Claimed Subject Matter:**

**Independent Claim 1**

Claim 1 recites a method for dynamically valuing and generating a promotional offer of an advertising message to be sent to at least one of a plurality of mobile terminal users. In the method, user profile information about mobile terminal users is maintained, e.g., user profiles are maintained in mobile user's location database 35 ([0038]) and/or mobile user profiles database 36 (paragraph [0047]) in FIG. 1. An advertising message to be sent to mobile terminals of selected mobile

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terminal users of the plurality of mobile terminal users located within a vicinity of a specific location of interest is created (see, e.g., FIG. 4 and ¶[0053]). The advertising message includes advertising content relating to at least one defined criterion (see, e.g., ¶[0045], ¶[0048], and step 90 of FIG. 3A) and a dynamically generated promotional offer regarding the advertising content (see, e.g., ¶[0049] and step 97 of FIG. 3A). The dynamically generated promotion offer is based on a number of the selected mobile terminal users (see, e.g., ¶[0049]): "The value may be dependent on one or more criteria, such as . . . , the number of persons to whom the advertising message is to be sent . . .").

At least one of the plurality of mobile terminal users is selected by matching the at least one defined criterion with the maintained user profile information, where the selected user(s) is located within a vicinity of a specific location of interest (see, e.g., step 101 of FIG. 3B and ¶[0052]). The value for the dynamically generated promotional offer of the advertising message is defined by the number of the selected mobile terminal users selected (see, e.g., step 102 of FIG. 3B and ¶[0052]). Lastly, the dynamically generated promotional offer of the advertising message is distributed to the mobile terminals of the selected mobile terminal users (see, e.g., step 103 and ¶[0052]).

#### **Independent Claim 5**

Claim 5 recites a method for dynamically generating an advertising message to be sent to mobile terminal users. In the method, at least one mobile terminal is selected using at least one defined criterion (see, e.g., ¶[0047] and FIG. 3A). An advertising message to be sent to the selected mobile terminal users is created (see, e.g., ¶[0049] and step 97 of FIG. 3A) including content dynamically generated based on a number of the selected mobile terminal users (see, e.g., ¶[0049]: "The value may be dependent on one or more criteria, such as . . . , the number of persons to whom the advertising message is to be sent . . .").

#### **Independent Claim 17**

Claim 17 recites a method for dynamically valuing a promotional offer of an advertising message to be sent to at least one mobile terminal user. In the method, user profile information about mobile terminal users is maintained, e.g., user profiles are maintained in mobile user's location database 35 (¶[0038]) and/or mobile user profiles database 36 (paragraph [0047]) in FIG. 1.

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A mobile terminal of a user is selected by matching the at least one defined criterion with the maintained user profile information, where the selected user is located within a vicinity of a specific location of interest (see, e.g., step 101 of FIG. 3B and ¶[0052] or step 96 of FIG. 3A). The value for the dynamically generated promotional offer of the advertising message is defined by the number of the selected mobile terminal users selected (see, e.g., step 102 of FIG. 3B and ¶[0052]). The dynamically generated promotional offer of the advertising message is distributed to the selected mobile terminal (see, e.g., step 103 and ¶[0052]). Lastly, the service user is debited for the price of the advertising message distributed to the selected mobile terminal (see, e.g., step 104 of FIG. 3B and ¶[0052]).

#### **Independent Claim 21**

Claim 21 recites a system for dynamically valuing and generating a promotional offer of an advertising message to be sent to at least one of a plurality of mobile terminal users. In the system, a network is in communication with a plurality of mobile terminals (see, e.g., mobile network 30, LAN 62, Internet 55, etc., of FIG. 1) and a server is in communication with the network (see, e.g., Local Ad Servers 40 in FIG. 1). The server itself comprises: means for selecting at least one mobile terminal using at least one criterion and the location of said mobile terminals relative to a specific location of interest (see, e.g., step 101 of FIG. 3B and ¶[0052]); means for maintaining information of the at least one of a plurality of mobile terminal users matching the at least one criterion (see, e.g., mobile user's location database 35 (¶[0038]) and/or mobile user profiles database 36 (paragraph [0047]) in FIG. 1); means for creating an advertising message to be sent to the selected at least one of a plurality of mobile terminals (see, e.g., advertiser/customer interface 180 in FIG. 1 and ¶[0053]), the advertising message including a promotional offer dynamically generated based on a number of mobile terminals selected using the at least one criterion to receive the advertising message (see, e.g., ¶[0049] and step 97 of FIG. 3A); means for defining a value of the advertising message including the promotional offer based on the number of the at least one of mobile terminal users matching the at least one criterion (see, e.g., step 102 of FIG. 3B, ¶[0052], and pricing software 49 in FIG. 1); and means for distributing the advertising message including the promotional offer to a mobile terminal of the at least one of a plurality of

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mobile terminal users matching the at least one criterion (see, e.g., ad server 40 in FIG. 1, step 103 in FIG. 3B, and ¶[0052]).

**Independent Claim 25**

Claim 25 recites a system for providing an advertising message to a plurality of mobile terminal users. In the system, a dedicated server (see, e.g., Local Ad Servers 40 in FIG. 1) communicates with a network for updating a database including information selecting at least one of a plurality of mobile terminals using at least one specific criterion (see, e.g., current service utilization database 45, criteria register 170, etc., in Ad Server 40' in FIG. 1). An advertising message to be sent to mobile terminals of selected mobile terminal users of the plurality of mobile terminal users located within a vicinity of a specific location of interest is created (see, e.g., FIG. 4 and ¶[0053]). The advertising message includes advertising content relating to at least one defined criterion (see, e.g., ¶[0045], ¶[0048], and step 90 of FIG. 3A) and a dynamically generated promotional offer regarding the advertising content (see, e.g., ¶[0049] and step 97 of FIG. 3A). The dynamically generated promotion offer is based on a number of the selected mobile terminal users (see, e.g., ¶[0049]: "The value may be dependent on one or more criteria, such as . . . , the number of persons to whom the advertising message is to be sent . . ."). Lastly, the system comprises a transceiver communicating with the dedicated server for transmitting the advertising message to the selected at least one of a plurality of mobile terminals (see, e.g., access points 60 in FIG. 1 and ¶[0043]).

**(vi) Grounds of Rejection to be Reviewed on Appeal:**

The rejection of independent Claims 1, 17, and 21 under 35 U.S.C. §103 as unpatentable over U.S. Patent No. 5,539,395 (Buss) in view of U.S. Patent No. 6,332,127 (Bandera).

The rejection of independent Claims 5 and 25 under 35 U.S.C. §102 as anticipated by Buss.

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Appealing Final Office Action dated November 12, 2004**(vii) Argument:****All independent claims (Claims 1, 5, 17, 21, and 25)**

None of the references (either alone or in combination) teach or suggest defining a value for the dynamically generated promotion offer of the advertising message based on the number of the at least one selected mobile terminal users that were checked and (known to be) located within a vicinity of a specific location of interest (which is recited in each of the independent claims of the present invention). For example, if ten users are detected as being located in the vicinity of a pizza parlor, and if the pizza parlor's total budget for promotional offers was \$100, each one of the ten users is dynamically computed to receive ten dollars of the promotional offer.

In Buss, the mobile terminal system merely filters messages which do not apply to the present location of the mobile terminal. In other words, the mobile terminal determines where it is located, and, based on that, filters out irrelevant messages. Filtering messages (by the individual mobile terminals) is the main disclosure of Buss. Specifically, Buss teaches a portable device which is capable of receiving a plurality of location based messages, determining the current location of portable device, and, based on that information, selecting a message that is suitable for the current location. Thus, for example, if a promotional offer for a particular pizza parlor was transmitted in the Buss system, there would be no way of knowing how many users are actually located in the vicinity of that particular pizza parlor, and therefore there is no way to dynamically value the promotion or e-coupon of each individual user. For example, if a \$10 promotional offer was offered in Buss, but the total promotional offer budget was \$100, and 50 users received and used the \$10 promotion, there would be a \$400 overcharge on the total promotional offer budget. Therefore, the claimed limitations provide fundamental differences. As the Examiner acknowledges, Buss does not expressly disclose the step of defining a price for the advertising message based on the number of mobile terminals matching the criterion.

Bandera teaches a method and system for providing time- and location-specific advertising via the Internet. According to the teachings of Bandera, advertising objects in displayed web pages can be changed based on the current location of the user terminal requesting the content (which it learns by the client terminal including its current location information in the request). In one embodiment, Bandera teaches the concept of using electronic coupons that are valid only at specific locations and at a specific time. A network registry may be utilized to

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reduce the risk of using certain coupon more than once, so the use of each of the coupons can be tracked. However, Bandera does not teach the step of dynamically valuing a coupon based on the number of user terminals matching certain criterion and located in the vicinity of the specific location of interest. Furthermore, it should be noted that the Examiner may be confusing the various values referred to in the present claims and in Bandera. In the present claims, the value is the value of the coupon (i.e., what the mobile terminal user will receive when using the coupon). By contrast, the value the Examiner cites in Bandera is the price the advertiser will pay for having the advertisement sent to the client terminal.

U.S. Patent No. 5,724,521 (Dedrick), which is cited against some of the dependent claims, teaches a metering service and charges an appropriately scaled fee to the advertiser depending upon where the end user reading the advertisement falls on a scale rating the end user's worth to the advertiser. In other words, Dedrick teaches a method and system for charging advertisers based on how well the consumer's profile matches the advertiser's defined profile as target customers for the advertisements. Further, the customers are credited for reading the advertiser's advertising messages. This disclosure in Dedrick has nothing to do with defining a value for the dynamically generated promotion offer of the advertising message based on the number of the selected mobile terminal users located within a vicinity of a specific location of interest, as recited in the independent claims of the present application.

Thus, even if Buss, Bandera, and Dedrick are combined, the limitations of the independent claims (i.e., Claims 1, 5, 17, 21, and 25) are not met because none of the references determines the number of devices present in the relevant area and selects the value of the promotional offer based on this determined number of devices present. At least based on their dependence from the independent claims, which are believed to be in condition for allowance, the dependent claims (i.e., Claims 2-4, 6-16, 18-20, 22-24, and 26-34) are also believed to be in condition for allowance.

**Independent Claims 1, 17, and 21: Impermissible Use of "Official Notice"**

In the Office Action proceeding the Final Office Action, the Examiner rejected independent Claims 1, 17, and 21 under 35 U.S.C. §103 as unpatentable over Buss in view of Dedrick. In the Final Office Action, the Examiner replaced the old grounds with the new grounds that independent Claims 1, 17, and 21 are unpatentable under 35 U.S.C. §103 over Buss in view of Bandera.

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However, the new grounds in the Final Office Action, starting on the bottom of page 5 to the top of page 15, are mostly a verbatim copy of the old grounds (from pages 4-5 and 10-17 of the previous Office Action).

The only substantial differences in the text of the Final Office Action from the text of the previous Office Action are contained in the opening response to appellants' previous arguments and the two passages from the bottom line of page 6 to the fourth line of page 7, and from the third sentence in the 2nd full paragraph on page 9 to the second sentence on page 10. This is significant because the two new passages (which presumably are the foundation for the new grounds) rely on the Examiner taking Official Notice of details missing from the cited references. In other words, the Examiner is using Official Notice to "fill in the gaps" in the cited references so that all the limitations of independent Claims 1, 17, and 21 can be shown as "taught" in his rejection.

This use of Official Notice is both improper and incorrect.

In February 2003, the first revision (Rev. 1) of the Eighth edition of the MPEP was published with a completely revised **§2144.03 Reliance on Common Knowledge in the Art or "Well Known" Prior Art**. This section needed to be rewritten because of decisions of the Federal Circuit which greatly limit the circumstances under which an Examiner can assert "Official Notice" without documentary evidence. Some specific passages (with emphasis added) from §2144.04 are reprinted below:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art ...; *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.").

It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence

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in the record in support of these findings."). While the court explained that, "as an administrative tribunal the Board clearly has expertise in the subject matter over which it exercises jurisdiction," it made clear that such "expertise may provide sufficient support for conclusions [only] as to peripheral issues." *Id.* at 1385-86, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002) (In reversing the Board's decision, the court stated "'common knowledge and common sense' on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation....The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.").

... Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). ... If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.

... If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

As the passages quoted from the most recent edition of the MPEP above show,

- "Official Notice" is only appropriate in limited circumstances, and it should be *rarely* used in a Final Rejection;
- If used, Official Notice should be taken of facts capable of instant and unquestionable demonstration;
- If not capable of instant and unquestionable demonstration, an asserted fact must be supported by a prior art reference; and
- If Official Notice is traversed by the applicant, the Examiner must provide documents supporting the alleged fact in the next Office Action; if necessary, the Examiner must provide an affidavit/declaration setting forth specific factual statements.

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As will be explained in detail below, in this Final Rejection, the Examiner is asserting "Official Notice" of the details which the Examiner admits are not taught by the cited prior art references. The Examiner took Official Notice of these details *for the very first time* in the Final Office Action. Appellants respectfully request an explanation of what "rare" circumstances has forced the Examiner to rely on "Official Notice" (for the first time) in this Final Rejection. In general, appellants respectfully suggest that, if there are no clearly extraordinary circumstances justifying the repeated reliance on Official Notice in this Final Rejection, the rejections in which Official Notice is used (which includes at least the rejection of independent Claims 1, 17, and 21) be withdrawn.

On page 7 of the Final Rejection, the Examiner admits that Buss "does not expressly disclose the steps of ... defining a monetary value related to the promotional offer based on the number of mobile terminal users selected, ..." as is recited in independent Claims 1, 17, and 21. Apparently the Examiner asserts that this shortfall is fixed because:

... It is also customary in the art for a product manufacturer, a product distributor, a coupon issuer or an advertiser providing one or more coupons, related to one or more specific products, to qualified users during a promotional period or advertising campaign to limit the number of coupons that can be distributed or issued to the users by tracking the coupon usage through redemption data or reports collected from associated retailers (See the Golden's Patent cited as prior art by the Applicant and Lemon's Patent in the conclusion section). Finally, it is well-established in the industry that an advertiser or a product promoter conducts an advertising or promotional campaign based on a fixed budget set aside to run the campaign including providing an incentive or a discount coupon to a limited group of users, wherein the monetary value associated with each offer or discount coupon or incentive is dependent upon the associated budget ("Official Notice").

(Final Rejection, page 9, line 14, to page 10, line 2)

To the extent that the above paragraph is understood, it is believed that the Examiner is using these "customary" and "well-established" facts of which the Examiner takes Official Notice to supply the missing step of "defining a monetary value" as recited in Claims 1, 17, and 21. This is unacceptable, both because it is inappropriate for the Examiner to use Official Notice for the first time in a Final Rejection and because, even if these "well-established" and "customary" facts were indeed true (which we do not admit), it does not mean that the step of "defining a value for the

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when the mobile users are within a geographic location proximate to a local store setting, for example, a product featured in the advertising message. Here, the advertising message content is specifically generated and targeted at the qualified mobile users in accordance with their purchase habits, stored in a database, wherein the advertising message is selected and presented to the users when they are in a location of interest. Technically speaking since the users' purchase habits or history is stored in a database and the targeted advertising message is specifically directed to the qualified mobile users' attention, then it can be inferred here that the system is capable of determining at any given time the number of qualified mobile users who will receive the (a) particular advertising message based on the users' purchase history stored in the database, as understood by professionals in the art. Hence, the prior art or the Buss's Patent does not have to explicitly disclose the argued claim limitations to render the claims (claims 5 and 25) anticipated. In other words, failure of those skilled in the art to contemporaneously recognize an inherent property, function or ingredient of a prior art does not preclude a finding of anticipation (MPEP 2131.01(III)).

(Final Rejection, page 2, line 19, to page 3, line 12)

To the extent that the above passage can be understood, it appears that the Examiner is arguing that the capability of "determining at any given time the number of qualified mobile users who will receive the (a) particular advertising message" is somehow inherently disclosed in Buss (or the "prior art") "based on the users' purchase history stored in the database, as understood by professionals in the art". First, it is difficult to understand the logic of this argument. Why would knowledge of a user's purchase history lead to knowing the location of the user's mobile terminal? Second, the Examiner appears to be relying upon an inherency argument which is both incorrect by law and incorrect by fact. Although the Examiner cites MPEP §2131.01 (III), it is respectfully suggested that MPEP §2112, entitled Requirements for Rejections based on Inherency; Burden of Proof, would be a better starting point for a rejection based on inherency. Subsection (IV) of §2112, part of which is reproduced below, has particular relevance here:

#### **IV. EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY**

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is

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dynamically generated promotional offer" as recited in the context of independent Claims 1, 17, and 20 is obvious. For example, the "knowledge" that the monetary value of a coupon is dependent upon a budget does not render the step of "defining a value for the dynamically generated promotional offer of the advertising message based on the number of the selected mobile users selected" obvious in light of the cited prior art.

On the basis of the above, withdrawal of the rejection of Claims 1, 17, and 21 (as well as all of their dependent claims) was respectfully requested in the Amendment After Final Rejection. In the alternative, if the rejection was maintained, appellants traversed the Official Notice of the Examiner (thereby triggering the MPEP requirement that the Examiner provide documents and/or affidavits/declarations supporting the alleged facts in the next Office Action). In addition, appellants reiterated their request that the Examiner provide, on the record, an explanation of what "rare" circumstances has forced the Examiner to rely on "Official Notice" in this Final Rejection. Finally, if the Examiner relies on either the "Golden's Patent" or the "Lemon's Patent" to maintain the rejection, appellants respectfully request the Examiner to cite the passages in those references on which the Examiner is relying for the alleged teachings.

#### Independent Claims 5 and 25: Improper Use of Inherency

In the Final Office Action, the Examiner maintains the same grounds of rejection for independent Claims 5 and 25 as in the previous Office Action; namely, independent Claims 5 and 25 were rejected under 35 U.S.C. §102 as anticipated by Buss.

Curiously enough, the Examiner asserts, in the February 8, 2005 Advisory Action, that the comments below, which are directed to the Examiner's use of inherent disclosure, are not appropriate because "arguments associated with inherency usually pertain to a 102 rejection instead of a 103 Rejection as featured in the last Office Action". However, in the section entitled "Claim Rejections - 35 USC §102" on page 15 of the Final Office Action, the Examiner rejected Claims 5 and 25 "under 35 U.S.C. 102(b) as being anticipated by Buss et al. (hereinafter Buss), US Patent 5,539,395A". Thus, the discussion of inherency below is apt.

In the Final Office Action, the Examiner asserts the following (emphasis added):

In general, Buss discloses sending a targeted advertising message to a plurality of qualified mobile users based on the users' purchase habits or history

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necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.).

As stated in the MPEP, to establish inherency, extrinsic evidence must show that the missing matter is *necessarily present* in the prior art reference. Furthermore, inherency may *not* be established by probabilities or possibilities: "the mere fact that a certain thing may result from a given set of circumstances is not sufficient". In the passage from the Final Rejection quoted above, the Examiner does not show how the feature of "determining at any given time the number of qualified mobile users who will receive the (a) particular advertising message" is necessarily present in Buss. Instead, the Examiner appears to indicate that the Buss system may be capable of "determining at any given time the number of qualified mobile users who will receive the (a) particular advertising message". In other words, the Examiner is establishing inherency by the possibility or probability of that feature being enabled by the Buss system. This is incorrect under the law, as stated in the MPEP.

Furthermore, this establishment of inherency is incorrect by the facts, because there is no reason to assume that the feature of "determining at any given time the number of qualified mobile users who will receive the (a) particular advertising message" is *necessarily present* in Buss.

On the basis of the above, withdrawal of the rejection of Claims 5 and 25 (as well as all of their dependent claims) is respectfully requested. Furthermore, if a rejection based on inherency is used, appellants respectfully request the Examiner clearly show the reasoning as to why the inherent feature is *necessarily present* in the prior art teaching.

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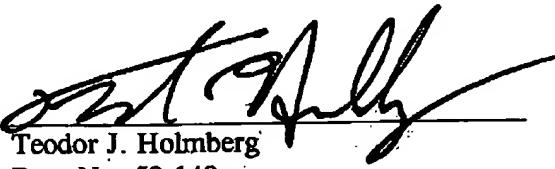
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On the basis of the foregoing, it is believed that all rejections in the Final Office Action are improper and should be withdrawn.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE

By \_\_\_\_\_

  
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Dated: July 14, 2005